

R E M A R K S**A. INTRODUCTION**

Claims 1-34 are pending and rejected.

Upon entry of this Amendment:

- Claims 1-34 will be pending
- Claims 1, 4, 5, 25, 33, and 34 will be amended
- Claims 1, 4, 5, 23, 24, 25, 33, and 34 will be the only independent claims

B. “DOUBLE PATENTING” REJECTION / OBJECTION PER RULE 78(B)

The Examiner states that Claims 1-34 “conflict” with claims 1-27 of Application No. 10/822,611.

Although the Examiner references a “double patenting” rejection, no basis for statutory or obviousness-type double patenting has been articulated. Applicants address below what appears to be an objection under Rule 78(b).

As a preliminary matter, Applicants respectfully wish to address the Examiner’s use of the word “equivalent” to describe different terminology in the claims. To clarify for the record, no terms that the Examiner alleges are “equivalent” terms are actually identical in meaning or scope.

“product guarantee” is not identical to “prize.” A prize may or may not comprise a “product guarantee.” Other types of prizes may be described in the Specification and/or within the level of ordinary skill in the art in light of the disclosure. “price level” is not identical to “measure of performance.” A measure of performance may or may not comprise a price level. Other types of measures of performance may be described in the Specification and/or within the level of ordinary skill in the art in light of the disclosure.

With respect to Claim 1 in the pending Application, the Examiner makes the conclusion that Claim 1 of the ‘611 application is a “broader genus” of present Claim 1. Although Claim 1 of the ‘611 application may be broader in some respects, it is narrower in others. For example, present Claim 1 recites *determining at least one prize to offer a player*; Claim 1 of the ‘611 application recites *determining at least one product guarantee to offer a player*. A product guarantee is one type of prize, but the terms are not identical in scope. Present Claim 1 accordingly contemplates prizes that may or may not comprise product guarantees. Accordingly, one could make and use the subject matter of present Claim 1

without infringing on Claim 1 of the '611 application (e.g., by determining a prize that is not a product guarantee), which is not a broader genus.

Applicants intend to address in the '611 Application the Examiner's concerns about allegedly "conflicting" claims between the two applications.

For at least these reasons, Applicants respectfully request the withdrawal of the objection to Claims 1-34 under Rule 78(b) in this Application.

C. SECTION 103(A) REJECTIONS

Claims 1-26 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (U.S. Publication No.2004/0148221), and further in view of Philyaw (U.S. Patent No. 6,631,404).

Claims 27-33 stand rejected as being unpatentable over Chu in view of Philyaw and in further view of Von Kohorn (U.S. Patent No. 5,697,844).

We respectfully traverse the Examiner's Section 103(a) rejection.

However, solely in order to expedite allowance of present Application for business reasons, Applicants have now amended all of the independent claims (Claims 1, 4, 5, 23, 24, 25, 33, and 34) to provide generally for a feature in which the user may have the opportunity to choose one or more products for which he will play or from which he will be able to select a prize. See, e.g., Specification [270-71]. In one example, prior to initiating game play, the user may choose a category of products, such as "household items," "restaurant items," or "premium products." Based on the user's choice of category, for example, the controller may determine one or more products that fall into the category. In another example, the user himself may choose one or more indicated individual products that he will play for (i.e., that he may be or become eligible to select at the end of the game).

Applicants respectfully submit that none of the cited references (Chu, Philyaw, Von Kohorn) teaches or suggests the recited subject matter in combination with features of:

prior to initiating play of a local edition of an online game including the game content, displaying to the player the least one prize;

prior to initiating play of the local edition of the online game, receiving an indication of a selection by the player of a prize, from the at least one displayed prize, that the player will play for; and
initiating play of the local edition of the online game

as now recited in independent Claim 1;

prior to generating the local edition of the game, receiving an indication of a selection by the user of at least one entitlement,

as now recited in independent Claim 4;

prior to initiating a game including the at least one game element,
transmitting to the user an indication of a plurality of retail entitlements;
prior to initiating the game, receiving an indication of a selection by the
user of at least one retail entitlement that the user will play for

as now recited in independent Claim 5;

prior to initiating a game, transmitting to the user an indication of the
plurality of prizes;
prior to initiating the game, receiving an indication of a selection by the
player, from the plurality of prizes, of at least one prize that the player will play
for;

initiating ~~a~~ the game;
determining a measure of performance of the player in the game;
determining, based on the measure of performance, whether to allow the
player to select at least one prize from the at least one prize that the player
selected to play for~~plurality of prizes;~~ and
receiving an indication of a selection by the player of at least one prize from
the at least one prize that the player selected to play for

as recited in independent Claim 23;

prior to initiating a game for the user including the at least one game element, transmitting to the user an indication of a plurality of retail entitlements;
prior to initiating the game, receiving an indication of a selection by the user of at least one retail entitlement that the user will play for

as recited in independent Claim 33;

prior to initiating the game for the user, receiving an indication of a selection by the user of at least one retail entitlement

as recited in independent Claim 34.

For at least these reasons, Applicants respectfully submit that all of the independent claims (Claims 1, 4, 5, 23, 24, 25, 33, and 34) and the dependent claims (Claims 2-3, 6-22, and 26-32) are in condition for allowance. The Examiner's reconsideration and withdrawal of the Section 103(a) rejection is respectfully requested.

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1050.00

Deposit Account: 50-0271

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Please credit any overpayment to the same account.

F. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

March 27, 2008
Date

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